

REMARKS

This is in full and timely response the Final Office Action mailed on June 8, 2004. Reexamination in light of the following remarks is respectfully requested.

Claims 13-25 are currently pending in this application, with claim 13 being independent.

Rejection under 35 U.S.C. §101

The Office Action includes a rejection of claims 4-6 under 35 U.S.C. §101, contending that the Applicant has claimed plural categories of invention in a single claim.

This rejection is respectfully traversed at least for the following reasons.

While not conceding the propriety of this rejection and in order to advance the prosecution of the above-identified application, claims 4-6 having been canceled without prejudice or disclaimer of their underlying subject matter, rendering this rejection as moot.

In response to the contention that the Applicant has claimed plural categories of invention in a single claim, statutory subject matter pursuant to 35 U.S.C. §101 includes claims drawn to *a process*, a machine, a manufacture, or composition of matter, or any new and useful improvement thereof. Please note that the term "process" found within section 101 means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material. 35 U.S.C. §100(b).

Regarding the non-entry of the amendment of May 21, 2004, page 2 of the Final Office Action acknowledges that, according to the preamble found within claim 4, claims 4-6 are drawn to "*a method for building an overhead infrastructure.*" Thus, page 2 of the Office Action acknowledges the existence of a method within the preamble, that method being "*a method for building an overhead infrastructure.*" But regarding the rejection of claims 4-6 under 35 U.S.C. §101, the Office Action contends that plural categories of invention are also found within claims 4-6. Specifically, the Final Office Action concludes without providing any evidentiary support

that both a process of making and a process of using an overhead infrastructure are found within the claims.

And even if present, the Final Office Action fails to provide any legal authority of any kind establishing that a claim having both a process of making and a process of using an overhead infrastructure is in conflict with 35 U.S.C. §101. In this regard, the classification system used in the U.S. Patent and Trademark Office has not been established as a basis of rejection pursuant to 35 U.S.C. §101.

Thus, the language found within claims 4-6 clearly identifies *process claims* drawn to *a method for building the overhead infrastructure*, which is clearly within a statutory class of inventions set out by 35 U.S.C. §101.

Withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. §112

This rejection is respectfully traversed at least for the following reasons.

Prior claim 4 includes:

a step of putting around the tensile line a plastically deformable coil having a metal wire formed in a spiral shape and synthetic resin coated on a surface of the metal wire,

a step of elongating the coil until its plastic deformation so as to form a basic construction with a series of overhead cableway capable of holding a plurality of overhead lines inside the spiral of the coil, and

a step of extending an overhead line in an empty space of the overhead cableway on demand,

wherein a plurality of overhead lines, respectively managed by each of a plurality of business conductors, are accommodated in the overhead cableway wherein a plurality

of overhead lines, respectively managed by each of a plurality of business conductors, are accommodated in the overhead cableway, and an administrator provides the business conductors with rights for using the overhead cableway for rent or for sale with a fee according to a number and weight of the overhead lines managed by each of the business conductors, and

wherein for the installation of the basic construction, tensile strength of the tensile line is set based on the maximum load estimated from an amount of the overhead lines possibly inserted in the overhead cableway.

While not conceding the propriety of this rejection and in order to advance the prosecution of the above-identified application, claims 4-6 having been canceled without prejudice or disclaimer of their underlying subject matter, rendering these rejections as moot.

The Final Office Action includes a rejection of claims 4-6 under 35 U.S.C. §112, first paragraph, contending that the claims fail to comply with the enablement requirement.

In response to this contention, “a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of Section 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support” (emphasis added). *Fiers v. Revel*, 25 USPQ2d 1601, 1607 (Fed. Cir. 1993).

The Final Office Action asserts that the skilled artisan would be unable to “manage the business conductors”, “provide for rent or sale with a fee according to the number and weight of the overhead lines”, or “set a size of the overhead cableway based on an estimated demand.” The Final Office Action asserts that there are no specific formulas presented in the specification to arrive at these calculations and that one skilled in the art would have to perform undue experimentation.

In response to this assertion, “section 112 requires only an objective enablement; the invention needs to be sufficiently disclosed through illustrative examples or terminology to teach those of ordinary skill in the art how to make and how to use the invention as broadly as it is claimed” (emphasis added). *Musco Corp. v. Qualite Inc.*, 41 USPQ2d 1954 (Fed. Cir. 1997). See also M.P.E.P §§2164.01, 2164.04. “The applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed.” *In re Alton*, 37 USPQ2d 1578, 1581 (Fed. Cir. 1996).

The rejection found within the Final Office Action contends that “manage the business conductors” is found within claims 4-6. However, the phrase “manage the business conductors” is not found within claims 4-6.

Regarding the term “provide for rent or sale with a fee according to the number and weight of the overhead lines”, the specification as originally filed includes illustrative examples or terminology for an administrator that provides the business conductors with rights for using the overhead cableway for rent or for sale with a fee according to a number and weight of the overhead lines managed by each of the business conductors. For example, paragraph [0047] provides that an administrator of the basic construction may provide the business conductors with rights for using the overhead cableway S for rent or for sale with a fee according to a number and weight of the cables C managed by each of the business conductors.

Regarding the term “set a size of the overhead cableway based on an estimated demand”, the specification as originally filed includes illustrative examples or terminology for prior claim 5 feature wherein for the installation of the basic construction, a size of the overhead cableway is set based on an estimated demand for the overhead lines. For example, paragraph [0041] provides that the installation of the basic construction, tensile strength of the messenger wire W is set based on the maximum load estimated from an amount of the cables C possibly inserted in the overhead cableway S. Paragraph [0042] describes an estimated demand for the overhead lines as the demand for cables C that may be required in the future.

Withdrawal of this rejection is respectfully requested.

The Final Office Action includes a rejection of claims 4-6 under 35 U.S.C. §112, second paragraph, contending that the claims are indefinite.

This rejection is respectfully traversed at least for the following reasons.

Intellectual Property Development Inc. v. UA-Columbia Cablevision of Westchester Inc., 67 USPQ2d 1385, 1389 (Fed. Cir. 2003) instructs that:

In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to ‘particularly point out and distinctly claim the subject matter which the patentee regards as his invention.’ The words used in the claims are examined from the perspective of a person skilled in the art. In the absence of an express intent to impart a novel meaning to claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. The ordinary and customary meaning of a claim term may be determined by reviewing a variety of sources. Some of these sources include the claims themselves; dictionaries and treatises; and the written description, the drawings, and the prosecution history. Citations omitted.

The Final Office Action contends that the term “managed” is vague and indefinite. In response to this contention, paragraph [0047] of the specification as originally filed provides that a plurality of cables C, respectively managed by each of a plurality of business conductors, are accommodated in the overhead cableway S to form the common use system of overhead infrastructure, thus the aforementioned various profits can be shared by business conductors. In this regard, the term “managed” is both clear and definite.

The Final Office Action contends that the term “business conductors” is vague and indefinite. In response to this contention, paragraph [0003] in the “Background of the Invention” provides that erection of the cables has been independently operated by each of business conductors. Paragraph [0003] further provides that when two business conductors erect

communication cables in the same section, those erection works may be separately done all the way. Paragraph [0003] additionally provides that whenever a business conductor erects a cable between utility poles, it is a common practice to extend a messenger wire. Paragraph [0005] in the “Background of the Invention” further provides that each of the business conductors usually complete by itself erection works including operations for drawing a messenger wire, thereby causing a problem to increase costs for construction. In addition, paragraph [0009] in the “Summary Of The Invention” provides that the basic construction may be used by a plurality of business conductors, so the work by each of business conductors to extend a tensile line such as a messenger wire may be omitted, thereby decreasing costs for constructing the overhead infrastructure. Paragraph [0011] in the “Summary Of The Invention” provides that a business conductor who does not have an infrastructure such as utility poles and tensile lines may be able to easily start a business utilizing overhead lines. Paragraph [0011] in the “Summary Of The Invention” provides that a part of core lines contained in the overhead line can be rented or sold to the business conductors. Paragraph [0046] provides that a plurality of cables C may be arranged in the overhead cableway S, thus an appearance and maintenance workability of the utility poles can be improved, and further provides that the aforementioned various profits can be shared by business conductors. In this regard, the term “business conductors” is both clear and definite.

The Final Office Action contends that the term “administrator” is vague and indefinite. In response to this contention, paragraph [0010] of the specification as originally filed provides that an administrator provides the business conductors with rights for using the overhead cableway for rent or for sale with a fee according to a number and weight of the overhead lines managed by each of the business conductors. Paragraph [0012] provides that the administrator who administrates the basic construction rents or sells the empty spaces in the overhead cableway to the business conductors for the purpose of extending the overhead lines, and, if necessary, remove a useless overhead line from the overhead cableway to make an empty space again. Paragraph [0047] provides that an administrator of the basic construction may provide the business conductors with rights for using the overhead cableway S for rent or for sale with a fee according to a number and weight of the cables C managed by each of the business conductors, and provides that the administrator of the basic construction may join the

communication business utilizing the cable C. In this regard, the term “administrator” is both clear and definite.

The Final Office Action contends that the term “rights” is vague and indefinite. In response to this contention, paragraph [0010] of the specification as originally filed provides that an administrator provides the business conductors with rights for using the overhead cableway for rent or for sale with a fee according to a number and weight of the overhead lines managed by each of the business conductors. Paragraph [0047] provides that an administrator of the basic construction may provide the business conductors with rights for using the overhead cableway S for rent or for sale with a fee according to a number and weight of the cables C managed by each of the business conductors. In this regard, the term “rights” is both clear and definite.

Withdrawal of this rejection is respectfully requested.

Rejection under 35 U.S.C. §103

Claims 4-6 were rejected under 35 U.S.C. §103 as allegedly being obvious over U.S. Patent 5,727,777 to Chikiri et al. (Chikiri) in view of U.S. Patent No. 2,155,053 to Kuenzi

This rejection is respectfully traversed at least for the following reasons.

While not conceding the propriety of this rejection and in order to advance the prosecution of the above-identified application, claims 4-6 having been canceled without prejudice or disclaimer of their underlying subject matter, rendering this rejection as moot.

In response to this rejection, claim 4 and the claims dependent thereon include a step of elongating the coil until its plastic deformation so as to form a basic construction with a series of overhead cableway capable of holding a plurality of overhead lines inside the spiral of the coil.

However, the Final Office Action admits that Chikiri does not specifically mention the process of “plastic deformation of the coil”. Yet the Office Action contends, without providing any evidentiary support, that it would have been obvious to the skilled artisan that plastic deformation must have taken place to form the coil shown in Figure 3A of Chikiri.

As a rule, “assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982). The support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

In this regard, the Final Office Action contends that the coil is elongated by being bent. In response to this contention, Chikiri arguably teaches that the spiral hanger 8 is bent in a spiral shape 13 extending in the longitudinal direction (column 3, lines 51-52), but fails to disclose, teach or suggest an elongation of the spiral hanger 8.

“Allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982).

In addition, “it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious” (citations omitted). *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *In re Dembiczak*, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999)(rejection based upon hindsight is reversed).

Furthermore, this assertion amounts to nothing more than an “obvious-to-try” situation. Specifically, “an ‘obvious-to-try’ situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued.” *In re Eli Lilly & Co.*, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Moreover, “an invention is ‘obvious to try’ where the prior art gives either no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful.” *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843, 1845 (Fed. Cir. 1989).

Here, the cited prior art does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. “Obvious to try” is not the standard under §103. *In re O'Farrell*, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

Withdrawal of this rejection is respectfully requested.

Double patenting rejection

Claims 4-6 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,505,818 to Nimiya et al. (Nimiya).

This rejection is respectfully traversed at least for the following reasons.

While not conceding the propriety of this rejection and in order to advance the prosecution of the above-identified application, claims 4-6 having been canceled without prejudice or disclaimer of their underlying subject matter, rendering this rejection as moot.

In response to this rejection, “a double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent” (emphasis added). M.P.E.P. §804 III. Because nonstatutory double patenting compares earlier and later claims, an earlier patent’s disclosure is not available to show nonstatutory double patenting. *Geneva Pharmaceuticals Inc. v. GlaxoSmithKline PLC*, 68 USPQ2d 1865, 1875 (Fed. Cir. 2003).

In this regard, the Final Office Action fails provide a comparison between the rejected claims 4-6 of the above-identified application and claims 1-8 of Nimiya. Thus, the double patenting rejection is premature.

Withdrawal of this rejection is respectfully requested.

Newly added claims

Claims 13 and the claims dependent thereon include the features of:

installing a basic construction, said basic construction including utility poles, a tensile line drawn between said utility poles, a plastically deformable coil suspended by said tensile line, and an overhead cableway, said overhead cableway being the space bounded by said plastically deformable coil; and

renting or selling a portion of said overhead cableway to a business conductor, wherein an administrator rents or sells said portion to said business conductor.

Chikiri arguably teaches a spiral hanger for a cable and method of installing a cable using the same, and Kuenzi arguably teaches a device for stringing wires. However, Chikiri and Kuenzi, either individually or as a whole, fail to disclose, teach or suggest renting or selling a portion of said overhead cableway to a business conductor, wherein an administrator rents or sells said portion to said business conductor.

The claims of Nimiya are drawn to a cable erection method carried out by using a plastically deformable coil comprising a metal wire formed in a spiral shape and synthetic resin coated on a surface of the metal wire and having an original non-elongated length defining a non-elongated state, wherein after said coil in a the non-elongated state having said original non-elongated length is disposed outside of and around a tensile line drawn between utility poles, the coil is elongated until its plastic deformation for forming a serial space for arranging cables inside the spiral, and a cable is extended, added or extracted through the space.

Nevertheless, renting or selling a portion of said overhead cableway to a business conductor, wherein an administrator rents or sells said portion to said business conductor, is not found within the claims of Nimiya.

Note that the same inventive entity is present in both the above-identified application and the Nimiya reference. Thus, the Nimiya reference is disqualified as prior art for the purposes of a rejection made under 35 U.S.C. §102, at least for this reason.

Further note that the above-identified application was filed after November 29, 1999. Moreover, the above-identified application and the Nimiya reference are commonly owned. As

a result, Nimiya is also disqualified as prior art for the purposes of a rejection made under 35 U.S.C. §103. 35 U.S.C. §103(c) and M.P.E.P §706.02(l)(1). Thus, any rejection of the claims under 35 U.S.C. §103 using Nimiya is also unavailable at least for this reason.

Allowance of the claims is respectfully requested.

Conclusion



For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: August 27, 2004

Respectfully submitted,

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